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EXAMINER	
GARG, YOGESH C	

ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 11/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/944,518	JANAKIRAMAN ET AL.	
	Examiner	Art Unit	
	Yogesh C. Garg	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 September 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *22-39* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *22-39* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's amendment under 37 CFR 1.121 received on 9/13/2006 is acknowledged and entered. Claims 1-21 were previously withdrawn. Claims 22, 28, and 34 are amended. Currently claims 22-39 are pending for examination.

Response to Arguments

2.. Applicant's arguments (see remarks pages 10-12) filed 9/13/2006 have been fully considered but they are not persuasive for following reasons:

2.1. The applicant argues (page 10, remarks) that , "Applicants' claims are directed towards restricting transfers of data from a server to the mobile device, while Agrawal's technology is directed towards the reverse transfer of information (e.g. from the mobile station to the base station) (ABSTRACT, col. 1 lines 59 - 61). In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case, examiner used combined teachings of McLain and Agrawal to render the applicant's claim obvious. McLain, as presented in the earlier office action teaches restricting transfers of data from a server to the mobile device (see at least Abstract, Fig.6 , col.2, lines 25-34, col.3, lines 40-49 and col.7, line 32-col.11, line 32. McLain teaches based upon receiving characteristic information of the mobile device pertaining to hardware/software capabilities the host computer, that is the web server in the claimed application,

transfers/downloads only selected essential content as desired). McLain teaches that such an action is taken by the server in response to signals receiving from hardware and software components of a mobile client device and those signals are related to the characteristics of their capabilities, such as limited capacity of the memory so that only selected or essential data is downloaded (Note: The available storage capacity of the memory of the mobile device at any time is not fixed but is variable depending upon how much it has been used and the server by restricting the transfers/downloads of the filtered essential data stops the wasting of the memory resulting in extending the use of the memory component). In response to applicant's argument that the Agrawal's technology restricts transfers of data from mobile device to a base station, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

The applicant argues (pg.10, Remarks), " (B) Applicants' claims are directed towards methods for restricting the information transmitted from a server to a mobile device based upon a variable condition, namely battery level, while McLain's technology is directed towards restricting the information transferred to a mobile device based upon a non-variable condition, namely memory capacity. Memory capacity would not change over time for a particular device, and thus McLain would not contain a suggestion to adapt or modify to determine which information objects to transfer based upon a variable condition". The examiner respectfully disagrees because McLain's suggestion of restricting downloads of data is not solely directed to the memory's capacity but instead it suggests that such transfers and downloads of data can be limited in response to receiving signals about the characteristics of the capabilities of

both hardware and software components of the mobile device (see at least Abstract) and the hardware and software components do include the battery of the mobile device. McLain does not explicitly disclose as an example the restriction of transfers of data based upon reducing battery power as it has shown for the capability of memory but it would be obvious to one of an ordinary skilled in the art at the time of the applicant's invention to have modified McLain in view of Agrawal's teachings to reduce or limit transfers/downloads of data to the mobile device on receiving signals of low battery power levels so as not waste the remaining battery power with irrelevant transfers/downloads of data as it is already doing with other components, for example storage capacity of the memory.

The applicant's arguments (page 11, Remarks), " Agrawal does not teach battery life.....non-essential web objects", attack the individual reference of Agrawal. In response to the applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). As shown above it is the combined teachings of McLain and Agrawal render the applicant's claims obvious.

The applicant further argues (page 11, Remarks) that there is no motivation or suggestion to combine and modify McLain and Agrawal. The examiner respectfully disagrees. In the instant case, examiner used combined teachings of McLain and Agrawal to render the applicant's claim obvious. McLain, as presented in the earlier office action teaches restricting transfers of data from a server to the mobile device (see at least Abstract, Fig.6 , col.2, lines 8-34, col.3, lines 40-49 and col.7, line 32-col.11, line 32. McLain teaches based upon receiving characteristic

information of the mobile device pertaining to hardware/software capabilities the host computer, that is the web server in the claimed application, transfers/downloads only selected essential content as desired). McLain teaches that such an action is taken by the server in response to signals receiving from hardware and software components of a mobile client device and those signals are related to the characteristics of their capabilities, such as limited capacity of the memory so that only selected or essential data is downloaded (Note: The available storage capacity of the memory of the mobile device at any time is not fixed but is variable depending upon how much it has been used and the server by restricting the transfers/downloads of the filtered essential data stops the wasting of the memory resulting in extending the use of the memory component). McLain's suggestion of restricting downloads of data is not solely directed to the memory's capacity but instead it suggests that such transfers and downloads of data can be limited in response to receiving signals about the characteristics of the capabilities of both hardware and software components of the mobile device (see at least Abstract) and the hardware and software components do include the battery of the mobile device. McLain does not explicitly disclose as an example the restriction of transfers of data based upon reducing battery power as it has shown for the capability of memory but it would be obvious to one of an ordinary skilled in the art at the time of the applicant's invention to have modified McLain in view of Agrawal's teachings to reduce or limit transfers/downloads of data to the mobile device on receiving signals of low battery power levels so as not waste the remaining battery power with irrelevant transfers/downloads of data as it is already doing with other components, for example storage capacity of the memory.

The applicant's arguments (page 12, remarks) regarding, "essential objects", have been noted and as per the MPEP guidelines would give the claim language the broadest possible interpretation. Further, the addition of the limitation, "**Providing a web server with at least two sets of web objects for a web page including at least set of web objects previously designated as essential objects"** does not find support in the originally filed specification including the originally filed claims. The originally filed specifications and the claims specify selecting essential objects and **nowhere they specify that such objects were previously specified.**

In view of the foregoing, the rejection of claims 22-29 is sustainable as being obvious over McLain in view of Agrawal. This is a Final office action.

Claim Rejections - 35 USC § 112

3.1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 22-34 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter , "**providing a web server with at least two sets of web objects for a web page including at least set of web objects previously designated as essential objects"** which was not described in the specification originally filed claims in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

application was filed, had possession of the claimed invention. The originally filed specifications and the claims specify selecting essential objects but do not disclose the step of listing that some objects were specifically previously designated as essential objects. Previously designated would imply that either a human or the system lists out the essential objects/information/data and only those listed or earmarked objects/information/data should be regarded as previously designated essential material but the applicant's disclosure does not teach or suggest the same. Therefore, the above recited limitation, when broadly interpreted in the light of the applicant's disclosure will not include irrelevant material or information, as also disclosed in McLain, see col.2, lines 8-16, which will unnecessary use space of the memory of the mobile device or use the low battery life of the mobile device. These limitations would be further treated as analyzed above for prior art rejection.

3.2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 22-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 22 recites the limitation "said advertisement" in line 11. There is insufficient antecedent basis for this limitation in the claim. Claims 28 and 34 also include the same deficiency and are therefore rejected for the same reason. Since claims 23-27, 29-33 and 35-39 are dependencies of claims 22, 28 and 34 they will inherit the same deficiency.

Specification

4. The currently amended independent claims 22, 28 and 34 and their dependencies filed 9/13/2006 are objected to under 35 U.S.C. 132(a) because they introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "**providing a web server with at least two sets of web objects for a web page including at least set of web objects previously designated as essential objects"** which was not described in the specification originally filed claims in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The originally filed specifications and the claims specify selecting essential objects but do not disclose the step of listing that some objects were specifically previously designated as essential objects. Previously designated would imply that either a human or the system lists out the essential objects/information/data and only those listed or earmarked objects/information/data should be regarded as previously designated essential material but the applicant's disclosure does not teach or suggest the same. Therefore, the above recited limitation, when broadly interpreted in the light of the applicant's disclosure will not include irrelevant material or information, as also disclosed in McLain, see col.2, lines 8-16, which will unnecessary use space of the memory of the mobile device or use the low battery life of the mobile device. These limitations would be further treated as analyzed above for prior art rejection.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5.1. Claims 22-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over McLain in view of Agrawal.

Regarding claim 22, McLain in view of Agrawal teaches a method for preserving battery life for a portable networked client device said method comprising the steps of:

providing a web server with at least two sets of web objects for a web page including at least set of web objects previously designated as essential objects, selecting only said essential web objects in a web page for transmission by said web server to said client device on receipt of a particular information about the mobile client device, otherwise selecting all web objects in both said essential set and said advertisement set; and transmitting said selected web objects from said server to said networked client device so that the remaining hardware and software component , such as that of a memory is not wasted, but in doing so its availability or life is

extended (see at least Abstract, Fig.6 , col.2, lines 8-16, lines 25-34, col.3, lines 40-49 col.7, line 32-col.11, line 32, col.8, lines 18-37 and col.9, line 51-col.10, line 34. McLain teaches providing a server with a plurality of web objects which include both essential that is relevant data and irrelevant, that is non-essential data. McLain fairly discloses and suggests that the data or web objects could be related to advertisement/graphical web objects/video segment & clip objects/sound and audio web objects/ multicolor web objects, see at least col.8, lines 18-37 and col.9, line 51-col.10, line 34 which disclose that the user's mobile device can receive multi-media data including web objects that are related to graphical web objects/video segment & clip objects/sound and audio web objects/ multicolor web objects. McLain also teaches that the user's mobile device can receive/download data from external sites which, as well-known, could include advertisements which could be displayed in the form of text/ graphical images/multicolor images. McLain teaches that based upon receiving characteristic information of the mobile client device pertaining to hardware/software capabilities the host computer, that is the web server in the claimed application, transfers/downloads only selected essential content as desired.).

McLain does not teach that the particular information received [by the web server that is the host computer in McLain] about the mobile client device is related to the condition of battery of the mobile client device being low, determining the condition of a battery in a networked client device and transmitting said battery condition from said mobile client device to the web server enabling the server to restrict the transfers of web objects so that the remaining battery life is extended for said networked client

device under conditions of low battery. However, in the same field of endeavor, Agrawal discloses determining the condition of a battery in a networked client device and transmitting said battery condition from said networked client device to a web server and if the battery condition is low prompting the receiving computing device to take action based upon the low condition of the battery(see at least Agrawal: Abstract, col.1, lines 44-67. Agrawal describes determining a particular parameter/characteristic of the mobile client device, that is battery power level of the mobile client device, and based on the detection of this parameter transmitting said parameter, that is battery condition to a base station which takes further action in response to detection of a particular parameter, that is low battery power level. The base station in Agrawal comprises a computer which receives the signal of low battery and so is the case in the claimed invention, that is a web server comprising a computer receiving the signal of low battery from a networked mobile client device).

In view of Agrawal, it would be obvious to one of an ordinary skilled in the art, at the time of the applicant's invention, to have modified McLain to combine Agrawal's features of determining the condition of a battery in the mobile client device and transmitting said battery condition from said mobile client device to the web server because, as taught in Agrawal, it would enable the host computer in McLain to further improve its objective of downloading data in mobile client devices efficiently from web sources without wasting the memory's storage capacity of the mobile client device and instead increasing the expected life (see McLain col.2, lines 8-17) by prioritizing the transmission/downloading of essential data as per the user's preference that is if the

user has indicated preference for audio data then to transmit on priority the audio data excluding the text/graphical/video data in order to complete the downloading efficiently of the required data only before the battery becomes dead.

McLain teaches (see at least Abstract, Fig.6 , col.2, lines 25-34, col.3, lines 40-49 and col.7, line 32-col.11, line 32) based upon receiving characteristic information of the mobile device pertaining to hardware/software capabilities the host computer, that is the web server in the claimed application, transfers/downloads only selected essential content as desired. McLain teaches that such an action is taken by the server in response to signals receiving from hardware and software components of a mobile client device and those signals are related to the characteristics of their capabilities, such as limited capacity of the memory so that only selected or essential data is downloaded (Note: The available storage capacity of the memory of the mobile device at any time is not fixed but is variable depending upon how much it has been used and the server by restricting the transfers/downloads of the filtered essential data stops the wasting of the memory resulting in extending the use of the memory component). McLain's suggestion of restricting downloads of data is not solely directed to the memory's capacity but instead it suggests that such transfers and downloads of data can be limited in response to receiving signals about the characteristics of the capabilities of both hardware and software components of the mobile device (see at least Abstract) and the hardware and software components do include the battery of the mobile device. McLain does not explicitly disclose as an example the restriction of transfers of data based upon reducing battery power as it has shown for the capability

of memory but it would be obvious to one of an ordinary skilled in the art at the time of the applicant's invention to have modified McLain in view of Agrawal's teachings to reduce or limit transfers/downloads of data to the mobile device on receiving signals of low battery power levels so as not waste the remaining battery power with irrelevant transfers/downloads of data as it is already doing with other components, for example storage capacity of the memory

5.2. Regarding claims 28 and 34, their limitations are closely parallel to the limitations of claim 22 and are therefore analyzed and rejected on the same basis.

5.3. Regarding claims 23-27, 29-33 and 35-39 , McLain in view of Agrawal discloses that the data or web objects could be related to advertisement/graphical web objects/video segment & clip objects/sound and audio web objects/ multicolor web objects (see at least col.8, lines 18-37 and col.9, line 51-col.10, line 34 which disclose that the user's mobile device can receive multi-media data including web objects that are related to graphical web objects/video segment & clip objects/sound and audio web objects/ multicolor web objects. McLain also teaches that the user's mobile device can receive/download data from external sites which, as well-known, could include advertisements which could be displayed in the form of text/ graphical images/multicolor images).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Both Collins (US Publication 20030009595A1, paragraph 13, pg.1) and Thielke et al. (US Patent 6,324,564, see col.4, lines 7-29) fairly teach and suggest that by reducing the transfer/downloading of data improves battery performance in communicating data.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on Increased Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Yogesh C Garg
Primary Examiner
Art Unit 3625

YCG
11/26/06